



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

X

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/724,390	11/26/2003	Luciano Hinojosa	1043.1005	9665

7590            07/06/2005

Marguerite Del Valle, Esq.  
Trademark & Patent Counselors of America, P.C.  
915 Broadway  
New York, NY 10010-7108

EXAMINER
----------

ADDIE, RAYMOND W

ART UNIT	PAPER NUMBER
	3671

DATE MAILED: 07/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/724,390	HINOJOSA, LUCIANO
	Examiner Raymond W. Addie	Art Unit 3671

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 04/11/05.

2a) This action is **FINAL**.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 3-10 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 3-10 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4, 5, 8-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 4, 5, 8-10 depend from canceled claim 1; and hence are indefinite.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 3, 6, 7 are rejected under 35 U.S.C. 102(a) as being anticipated by roller.

Roller # 6,494,640 B2.

Roller discloses a column protector (10) that can be attached to an I-beam (12), in order to protect vehicles and drivers that may impact a post, pole or the like, such as a guard rail post. Said protector comprising:

A circular exterior configuration (52) that could be formed by extrusion.

An inner configuration complementary to the shape of the I-beam being protected.

A sinuous interior profile formed by stiffening ribs (54, 62); that further create energy damping air pockets (56).

An plurality of open sections (46, 40).

Wherein the protector further comprising 2 sections (14, 16), each having a wide portion disposed between 2 narrow sections. See figs. 2A, 4A. Said relatively wide sections being intended to be the primary impact face of the protector.

In regards to claim 6; the recitation "the integral body is the product of an extrusion process". Appears to be a Product by Process limitation, which is not given patentable weight, since, determination of patentability is based on the product itself.

See MPEP 2113. Hence, claim 6 is examined as to the structural features of the claimed invention.

#### ***Response to Amendment***

3. Applicant's amendment to the Abstract has overcome the objection of the Last Office Action. Further, cancellation of claims 1 and 2 is acknowledged, and the 35 U.S.C. 112 2<sup>nd</sup> paragraph and 102 (b) rejection of claims 1, 2 are withdrawn.

#### ***Response to Arguments***

4. Applicant's arguments filed 04/11/2005 have been fully considered but they are not persuasive.

Applicant argues "Roller's apparatus requires more elaborate attachment by a belt or a strap".

However, in response to Applicant's argument that Roller includes additional structure not required by Applicant's invention, it must be noted that Roller discloses the invention as claimed. The fact that it discloses additional structure not claimed is irrelevant.

Applicant then argues "Roller's individual semi-cylindrical components 14, 16, 114 do not surround the support post and have a sinuous internal configuration".

However, the Examiner does not concur because the claims do not require a protector to surround the post, nor do the claims require a sinuous internal configuration.

Perhaps Applicant is referring to limitations in canceled claims 1 and 2?

Applicant then argues "Roller's apparatus is primarily intended to protect columns and supports from damage while reducing damage to vehicles impacting it...Applicant's claimed invention is intended to protect a person for example an accident victim from catastrophic injury".

However, the intended use of an invention cannot be used to show unobviousness of the claim limitations, where the prior art is capable of performing the same intended use or function.

In this case, the protector of Roller is capable of protecting the support post from impacting damage regardless of what is impacting the protector, be it human, machine or rock slide.

Therefore, the argument is not persuasive and the rejection is maintained.

Applicant then argues "claims 4-10 depend from claim 3 and are therefore, believed allowable with claim 3 for the reasons that claim 1 is believed allowable".

However, Applicant is reminded Claim 1 has been cancelled and cannot be allowable since it is canceled and Claims 4, 5, 8-10 all depend from canceled claim 1. Therefore, the argument is not persuasive and the rejection is maintained.

### ***Conclusion***

**5. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

Art Unit: 3671

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raymond Addie whose telephone number is (571) 272-6986. The examiner can normally be reached on Monday-Saturday from 7:00 am to 2:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas B. Will, can be reached on (571) 272-6998.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thomas Will  
Supervisory Patent Examiner  
Group 3600

RWA  
6/76/2005